

Serial No. 10/766,321

Attorney Docket No. 14-025

REMARKS

Claims 1 and 5 – 8 are pending. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1 and 5 – 8 are objected to for lack of antecedent basis. Claims 1 and 5 – 8 have been amended to provide proper antecedent basis for each of the items listed in the office action. Reconsideration and withdrawal of the objection is respectfully requested.

Claims 1 and 8 were rejected under 35 USC 103(a) as being unpatentable over JP 2001033356, Sakiyama et al. ("Sakiyama") in view of U.S. Patent No. 3,601,655, Andersen ("Andersen"). Claim 5 was rejected under 35 USC 103(a) as being unpatentable over Sakiyama in view of Andersen, further in view of U.S. Patent No. 5,629,606, Asada ("Asada"). Claims 6 and 7 were rejected under 35 USC 103(a) as being unpatentable over Sakiyama in view of Andersen, further in view of U.S. Patent No. 5,568,529, Masuda ("Masuda").

Claim 1 has been amended. Support for the amendment is located in the specification, for example, page 11, lines 6 – 9. The applicants respectfully request that these rejections be withdrawn for the following reasons, which are provided by way of example.

Independent claim 1 recites in combination, for example, "a signal abnormality detection portion for detecting a signal abnormality, the signal abnormality being temporarily reproduced when a repair center vibrates a signal wire of the vehicle to provide a detection result;" "a holding portion for latching the detection result as a latch signal when the signal abnormality detection portion detects the signal abnormality;" "an output circuit for outputting the latch signal;" and "an external connection unit, being connected to the output circuit only when the repair center checks for the signal abnormality so as to receive the latch signal, wherein the external connection unit is provided with a warning device that issues the warning when the

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signal abnormality is detected." Thereby, a tester device can be connected to the output circuit, e.g., of a vehicle's VSU-ECU when an inspection is carried out at a vehicle dealer, service center, or the like.

On the other hand, without conceding that Sakiyama discloses any feature of the present invention, Sakiyama is directed to a diagnosis method and diagnosis device for wire harnesses. It appears that, according to Sakiyama, the diagnosis device may be used to check wire harnesses, e.g., in factories, using an examining table 11, wire harnesses 12, 13, a speaker 23, and a signal generation apparatus.

In addition, the office action cites Andersen with respect to claim 1. Andersen is directed to a circuit continuity monitoring, warning and proving device. According to Andersen, a warning lamp in the vehicle instrument panel (e.g., col. 2, lines 46 – 49) is provided in the event that an electrical detonation device in an airbag system is inoperative. (E.g., abstract.)

To properly reject a claimed invention, the examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references when combined). In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). If a proposed modification of a reference would render the reference invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Moreover, if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

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The applicants provide herein a selection of some examples of limitations in the claims which are neither taught nor suggested by Sakiyama. The final Office Action admits that Sakiyama "do not teach a warning device." (Final Office Action, ¶ 3). Recognizing that Sakiyama fails to teach and/or suggest the invention as claimed, Andersen is cited to remedy the deficiencies:

Nevertheless, Andersen fails to remedy such deficiencies. For example, Andersen fails to teach or suggest "an external connection unit, being connected to the output circuit only when the repair center checks for the signal abnormality." To the contrary, Andersen teaches that the warning device (e.g., warning lamp in vehicle instrument panel) is permanently connected. Moreover, according to Sakiyama, Drawing 3, the counter 43 (cited as equivalent to the output circuit) and display 44 (cited as equivalent to the external connection unit) are illustrated as permanent parts of the flow/hits detection equipment 22 (Drawing 2). Therefore Sakiyama teaches that the external connection unit is permanently part of the output circuit.

Hence, Sakiyama and Andersen, alone or in combination, fail to teach or suggest the combination of features recited in independent claim 1, when considered as a whole.

Moreover, the basis for the combination proposed in the office action contradicts a fundamental principle of operation of one of the references, Sakiyama. In other words, a modification to the basic principles of operation of Sakiyama would have to be presumed to support the rejection. Particularly, modifying and combining Sakiyama with Anderson would turn Sakiyama's continuity/momentary break detecting circuit 22 into an alarm notification, thereby destroying Sakiyama's nature of operating to detect "chattering which repeats a flow and un-flowing in that part" [see paragraph [0011]]. Sakiyama is intended for use with a counted value: Sakiyama explains that "since the count of hits counts with a counter 43, a faulty

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connection's extent can be known by that counted value." Notwithstanding that Sakiyama principle of operation teaches trouble shooting on an examining table where the count of hit counts can be analyzed, the office action proposed adding Andersen's warning lamp in the vehicle instrument panel to indicate "critical events." Because the proposed combination would require a fundamental change to the principle of Sakiyama's operation, the proposed combination fails to teach or suggest the claimed invention.

In addition, Sakiyama is clearly deficient considering the invention claimed as a whole, for the reasons provide above.

Where the traversal of the rejection meets even the "preponderance of the evidence" standard, the rejection(s) set forth in the office action withdrawn. *In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992)*

With respect to the rejected dependent claims, the applicants respectfully submit that these claims are allowable not only by virtue of their dependency from independent claim 1, but also because of additional features they recite in combination.

The applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. The applicants do not concede that the cited prior art shown any of the elements recited in the claims. However, the applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

The applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of

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simplicity, applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

The applicants respectfully request entry of the present amendment for the following reasons. First, the amendments to the claims are necessary to further clarify the claimed invention to the Examiner with respect to claiming the full scope of patent protection which the applicants believe is appropriate and/or to address claim informalities. These amendments address the Examiner's issues with respect to the claimed invention, and most were unable to be introduced earlier since additional rejections were included in the Final Office Action.

Second, the amendments to the claims do not raise new issues requiring further search since the amendments include a narrowed and/or broadened scope of protection that should not be burdensome for the Examiner to review.

Third, the applicants respectfully submit that no new matter has been introduced. In addition, the amendments made to the claims are minor changes performed in response to the Examiner's comments.

Fourth, the amendments to the claims place the application in better form for appeal by materially simplifying the issues, i.e., correcting formality requirements and clarifying the asserted patentable distinctions over the prior art. Accordingly, the applicants respectfully request entry of the present Amendment.

In view of the foregoing, the applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

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Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,



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